

Remarks

The examiner has objected to the drawings. The drawings indicate that the reference number to the battery is correctly depicted as reference number 31. Applicant submits that the it is the specifications that is incorrect in naming both the thermal detector and the battery as reference number 21. Applicant has now corrected the specification to change battery reference number 21 to reference number 31.

Claims 1-6, and 9-17 have been rejected under 35 U.S.C. §103 as being obvious by Lezotte in view of Morris. Applicant respectfully disagrees with the examiner's position and hereby requests reconsideration in view of the following argument.

Applicant's claim 1 defines a heat source locator to be used in combination with a light viewing device enabling one to view a light outside the visible spectrum of a human is disclosed. The heat source locator comprises thermal detection means for detecting a thermal change within a field of view. The thermal detection means has an axis generally linear centralized within the field of view, and an indicator which indicates the sensing of a heat source. The heat source locator also has light emitting means for generating light having a wavelength outside the visible spectrum of a human. The light beam is aligned generally parallel and closely adjacent to the thermal detection means axis. With this construction, an operator may locate a heat source by sensing the presence of the heat source through the thermal detection means and then locate the position of the located heat source by directing the light beam from the light emitting means while viewing the location with a light viewing device.

Applicant respectfully submits that the patentable element in the present application is the fact that the light produced by the locator is emitted at a wavelength which is invisible to humans.

As the examiner correctly pointed out the light emitted by the LeZotte patent is visible light. However, the examiner has taken the position that the light emitted from the Morris patent discloses light emitting means having a light beam of a wavelength outside the visible spectrum of a human.

Applicant respectfully submits that it is improper to combine the teachings of LeZotte with that of Morris as such a combination would destroy the intended use of both inventions. The LeZotte patent discloses a **flashlight** which must use visible light, otherwise it is not a flashlight. To effectively remove the light means from LeZotte and replace it with the infrared light source of Morris would destroy the intended use of the LeZotte reference as it would no longer operate as a flashlight. Similarly, if the night vision device of Morris were to replace the infrared light source shown in the patent with a visible light source shown in the LeZotte patent the intended purpose of the Morris device would again be destroyed. The Morris night vision device specifically utilizes an infrared light source to avoid detection, the addition of the visible light source of LeZotte would greatly reduce this objective. Furthermore, this combination would only produce a night vision device with a visible light addition, this would not produce a heat detecting device at all.

As such, Applicant respectfully submits that it is improper to combine the references sighted by the examiner to render Applicant's invention obvious. Furthermore, neither reference sighted by the examiner indicate, suggest or motivate one to depart from the clear teachings of the invention, much less the intended objective of the inventions, and combine the teachings as suggested by the examiner. Clearly, LeZotte is intended to utilize visible light to render the device a flashlight and Morris is intended to utilize invisible light to render it undetectably. These references and their intended purposes are diametrically opposed to each other.

It is well settled that the obviousness of an invention cannot be established by combining the teaching of the prior art absent some teaching, suggestion or incentive supporting the combination, see *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *Ashland Oil, Inc. v. Delta Resins and Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985). Moreover, the mere fact that the prior art could be modified in the manner suggested by the examiner does not make such a modification obvious unless the prior art fairly suggests the desirability of the modification, see *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Here, the references do not suggest any motivation for, or the desirability of, Applicant's unique construction of the thermal detector in conjunction with an invisible light source. As such, it is improper to utilize these references to establish obviousness.

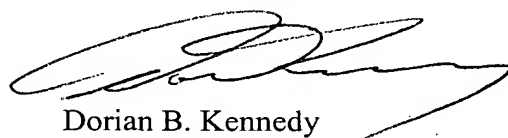
It is acknowledged that the tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. MPEP 2142. This is "especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'". *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) citing *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). With this in mind, a hindsight-based obviousness analysis must be supported by evidence which is "clear and particular". *In re Dembiczak*. It is insufficient

to simply offer a broad range of sources or to make **conclusory statements**, as “[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’”. *Id.* Applicant respectfully submits that the examiner has claimed the present invention to be obvious utilizing hindsight, speculation and conclusory statements which are not, in fact, supported by the cited references, to come up with a combination that would either destroy the clear intention of the reference or modify such in a manner that goes against the clear teachings of the reference. Furthermore, it is submitted that it is only through such hindsight that the Applicant’s invention can be gleaned from the cited references. Applicant respectfully contends that the invention is not obvious, but instead is novel and therefore worthy of patent protection.

Applicant submits that as independent claims 1, 6 and 13 all include the limitation of the invisible light source the just submitted argument applies equally to all such claims.

By this Amendment it is believed that the application has now been placed in condition for allowance. An early notice to such effect is accordingly solicited.

Respectfully submitted,



Dorian B. Kennedy
Reg. No. 36,840

BAKER, DONELSON, BEARMAN, CALDWELL & BERKOWITZ
Suite 900
Five Concourse Parkway
Atlanta, Georgia 30328
(770) 396-2244

Docket No. 170566-00006


Signature

SET OF ALL PENDING CLAIMS

1. (Currently Amended) A heat source locator to be used in combination with a light viewing device enabling one to view a light outside the visible spectrum of a human, the heat source locator comprising:

thermal detection means for detecting a thermal change within a field of view, said thermal detection means having a central axis within said field of view and an indicator which indicates the sensing of a heat source; and

light emitting means for generating light, said light emitting means having a light beam of a wavelength outside the visible spectrum of a human, said light beam being aligned generally parallel and closely adjacent to said thermal detection means axis;

whereby an operator ~~may~~ locates a heat source by sensing the presence of the heat source through the thermal detection means and then locating the position of the located heat source by directing the light beam from the light emitting means while viewing the location with a light viewing device.

2. (Original) The heat source locator of claim 1 further comprising a second light emitting means, said second light emitting means generating a beam of light in a visible spectrum and being aligned generally parallel and closely adjacent to said axis of said thermal detection means.

3. (Original) The heat source locator of claim 1 wherein said thermal detection means produces a visual indication of the sensing of a heat source.

4. (Currently Amended) The heat source locator of claim 1 wherein said thermal detection means produces an audible ~~indication~~ sound of the sensing of a heat source.

5. (Original) The heat source locator of claim 4 wherein said thermal detection means includes an earpiece speaker.

6. (Currently Amended) A heat source locator comprising;
a housing;
a thermal detector mounted within said housing to detect a heat source generally along a field of view; and

B2
Cont.
a light emitting device mounted within said housing positioned to emit a beam of light having a wavelength outside the visible spectrum of a human and generally centered along said thermal detector field of view;

whereby an operator ~~may~~ locates a heat source by sensing the presence of the heat source through the thermal detector and then locating the position of the heat source by directing the light beam from the light emitting device while viewing such with a light viewing device adapted to view the emitted wavelength.

7. (Cancelled)

8. (Cancelled)

9. (Previously ^{Presented} ~~Amended~~) The heat source locator of claim 6 further comprising a second light emitting means, said second light emitting means generating a beam of light in a visible spectrum and being aligned generally parallel and closely adjacent to said thermal detection means linear direction of sensitivity.

10. (Original) The heat source locator of claim 6 wherein said thermal detection means produces a visual indication of the sensing of a heat source.

11. (Currently Amended) The heat source locator of claim 6 wherein said thermal detection means produces an audible ~~indiction~~ sound of the sensing of a heat source.

12. (Original) The heat source locator of claim 11 wherein said thermal detection means includes an earpiece speaker.

13. (Currently Amended) A heat source locator system comprising;
a thermal detector having a beam of sensitivity along a central axis;
a light emitting device positioned to produce a beam of light having a wavelength outside the visible spectrum of a human and aligned generally along said thermal detector beam of sensitivity central axis; and

a light viewing device adapted to enable a viewer to view the light produced by said light emitting device,

whereby an operator ~~may~~ locates a heat source by sensing the presence of the heat source through the thermal detector and then locating the position of the heat source by directing the light beam from the light emitting device while viewing the location with the light viewing device.

14. (Original) The heat source locator of claim 13 further comprising a second light emitting means, said second light emitting means generating a beam of light in a visible spectrum and being aligned generally parallel and closely adjacent to said thermal detection means linear direction of sensitivity.

BA
cmh 15. (Original) The heat source locator of claim 13 wherein said thermal detection means produces a visual indication of the sensing of a heat source.

16. (Currently Amended) The heat source locator of claim 13 wherein said thermal detection means produces an audible ~~indiction~~ sound of the sensing of a heat source.

17. (Original) The heat source locator of claim 16 wherein said thermal detection means includes an earpiece speaker.